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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MILIA, MARK R	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/986,476	TANAKA, KEISUKE	
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,7-9,11,12,14-16 and 18-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,7-9,11,12,14-16 and 18-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/23/06 and has been entered and made of record. Currently, claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, and 18-22 are pending.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

3. Applicant's amendment to claim 22 to replace the indefinite term "low" with "lower" to particularly point out and distinctly claim the subject matter which applicant regards as the invention has overcome the rejection as cited in the previous Office Action. Therefore the rejection has been withdrawn.

Response to Arguments

4. Applicant's arguments, see pages 9-13, filed 10/23/06, with respect to the rejection(s) of claim(s) 1, 8, 15, and 22 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art and a different interpretation of the previously applied references.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 2, 4, 8, 9, 11, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US 6657702) in view of Enomoto (US 5974401).

Regarding claim 1, Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time

the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly setting a predetermined storage period of the image data and displaying the predetermined storage period on the user terminal.

Enomoto discloses setting a predetermined storage period of the image data (see column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print) and displaying the predetermined storage period on the user terminal (see column 3 lines 21-23, column 6 lines 44-50, column 7 lines 15-22, and column 8 lines 19-33, reference states that the user inputs option data, of which storage time designation is a part of, via a data input screen by using a mouse and a keyboard).

Regarding claim 8, Chui discloses a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), wherein the server stores the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-

column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly if a predetermined storage period of the image data is set, the server displays the predetermined storage period on the user terminal.

Enomoto discloses if a predetermined storage period of the image data is set, the server displays the predetermined storage period on the user terminal (see column 3 lines 21-23, column 6 lines 44-50, column 7 lines 15-22, and column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print, reference also states that the user inputs option data, of which storage time designation is a part of, via a data input screen by using a mouse and a keyboard).

Regarding claim 15, Chui discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the program comprising the procedures of: accepting transfer of the image data to the server and

storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65 and column 12 lines 39-51) and receiving the order f or the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly setting a predetermined storage period of the image data and displaying the predetermined storage period on the user terminal.

Enomoto discloses setting a predetermined storage period of the image data (see column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print) and displaying the predetermined storage period on the user terminal (see column 3 lines 21-23, column 6 lines 44-50, column 7 lines 15-22, and column 8 lines 19-33, reference states that the user inputs option data, of which storage time designation is a part of, via a data input screen by using a mouse and a keyboard).

Chui & Enomoto are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the setting or a storage period, as described by Enomoto, with the system of Chui.

The suggestion/motivation for doing so would have been to provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user.

Therefore, it would have been obvious to combine Enomoto with Chui to obtain the invention as specified in claims 1, 8, and 15.

Regarding claims 2, 9, and 16, Chui further discloses accepting and storing image data (see column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8 and column 14 lines 47-52) and Enomoto further discloses accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred (see abstract, column 3 lines 45-48 and 61-63, column 4 lines 61-65, column 6 lines 23-54, and column 7 lines 15-22, reference shows that the order data and image data are transmitted at the same time to the photo-finisher for output and delivery of prints).

Regarding claims 4, 11, and 18, Enomoto further discloses deleting the image data from the server after the predetermined storage period has elapsed since the image data were put into storage (see column 8 lines 19-26, reference discloses setting a storage time period, after which the image is no longer available, or deleted).

Regarding claims 7, 14, and 21, Chui further discloses if the order for the print of the image data is an order for a postcard which has seasonality (see column 4 lines 13-22 and column 23 lines 9-23) and Enomoto further discloses setting the predetermined storage period of the image data to a period corresponding to a content of a postcard (see column 3 lines 21-23, column 6 lines 44-50, column 7 lines 15-22, and column 8 lines 19-33, reference states that the user inputs option data, of which storage time designation is a part of, the storage time can be any amount of time the user desires).

7. Claims 20 and 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui in view of Enomoto and U.S. Patent No. 6556817 to Souissi et al.

Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Chui does not disclose expressly determining a time of day when communications costs are lower than at other times of day, performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower, and writing a storage period of the image data in tag information of the image data.

Enomoto discloses writing a storage period of the image data in tag information of the image data (see column 8 lines 19-33).

Souissi discloses determining a time of day when communications costs are lower than at other times of day and performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower (see column 5 lines 26-32 and column 6 lines 33-57).

Chui, Enomoto, & Souissi are combinable because they are from the same field of endeavor, transmission of data over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the writing a storage period of the image data in tag information, as described by Enomoto, and the transferring of image data to a server when communications costs are low, as described by Souissi, and which is well known and commonly used, with the system of Chui.

The suggestion/motivation for doing so would have been to save money and be able to provide lost cost prints to a user by utilizing low cost communications and purging of image files after a certain period of time.

Therefore, it would have been obvious to combine Enomoto and Souissi with Chui to obtain the invention as specified in claim 22.

Regarding claim 20, Enomoto further discloses displaying the storage period on the user terminal (see column 3 lines 21-23, column 6 lines 44-50, column 7 lines 15-22, and column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print, reference also states that the user inputs option data, of which storage time designation is a part of, via a data input screen by using a mouse and a keyboard).

8. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui and Enomoto as applied to claims 1, 8, and 15 above, and further in view of Fredlund et al. (US 6154295).

Chui and Enomoto do not disclose expressly extending the storage period for the image data regarding which the order was placed.

Fredlund discloses extending the storage period for the image data regarding which the order was placed (see column 3 lines 47-54).

Chui, Enomoto & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the extension of storage period as described by Fredlund, with the system of Chui and Enomoto.

The suggestion/motivation for doing so would have been to provide a user with greater control over the transmitted images and decrease the amount of memory needed to store image data by purging the image data that is not used after a predetermine amount of time.

Therefore, it would have been obvious to combine Fredlund with Chui and Enomoto to obtain the invention as specified in claims 5, 12, and 19.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
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MRM

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